

95-2864

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* FRED ARIAS

Appeal No. 95-2864  
Application 07/897,907<sup>1</sup>

ON BRIEF

MAILED

SEP 19 1995

PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before LYDDANE, FRANKFORT, and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

Fred Arias (appellant) appeals from the final rejection of claims 11-16, 19 and 20. Claims 6-8, 17 and 18 have been

<sup>1</sup> Application for patent filed June 12, 1992.

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canceled. Claims 1-5, 9 and 10, the only other remaining claims in the application, have been allowed. We *affirm-in-part*.

The appellant's invention pertains to a carrier for allowing a user to transport pairs of skis and poles. Details of the invention are readily apparent from a reading of exemplary claim 11, a copy of which is appended to this opinion.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 are:

Rischar	794,948	Jul. 18, 1905
Mazzoni, Jr. (Mazzoni)	3,960,302	Jun. 1, 1976
Saka	4,456,284	Jun. 26, 1984
Dyess	4,470,528	Sep. 11, 1984

Claims 11, 12, 15, 16, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mazzoni in view of Rischar.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mazzoni in view of Rischar and further in view of Saka.

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Claim 11 stands further rejected under 35 U.S.C. § 102(b) "as being anticipated by Rischard *and* Dyess" (supplemental answer, page 2; emphasis added).<sup>2</sup>

The rejections are explained in the examiner's answer (pages 4-8) and the supplemental answer.

The opposing viewpoints of the appellant are found in the opening brief (pages 5-12) and the reply brief.

#### *The § 103 Rejections*

The test for obviousness as stated in the decision of *In re Gorman*, 933 F.2d 982, 986, 8 USPQ 1885, 1888 (Fed. Cir. 1991) is "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention." Our reviewing court has also stated "that the prior art as a whole must suggest the desirability . . . of making the combination." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). A predecessor of our reviewing court has

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<sup>2</sup>This is a new rejection made for the first time in the examiner's answer. In the original statement of the rejection on page 7 of the answer, the rejection was incorrectly stated to be based on "Rischard and Saka." That the examiner intends the rejection to be based on "Rischard and Dyess" is made clear in the supplemental answer.

stated that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In the present instance, we agree with the examiner that the combined teachings of Mazzoni and Rischarde would have suggested the subject matter set forth in independent claim 11. With regard to the basic proposed combination of the two references, we share the examiner's view that it would have been obvious to include a cross strap in Mazzoni to prevent the shoulder strap 10 from slipping off of the shoulder of the user in view of Rischarde. Rischarde's express teaching of providing "a chest-strap 13, connected by the ends to the shoulder-strap and passing around the person beneath the arm . . . to retain the shoulder-strap in position" (page 1, lines 47-50) would have provided ample suggestion for this modification.

The appellant's argument that there is nothing in Mazzoni which would have suggested the desirability of adding a cross strap of any kind is noted. This argument amounts to a

discussion of the deficiencies of the Mazzoni reference taken individually rather than in combination as applied by the examiner. Accordingly, it has no immediately apparent relevancy to the issues presented by the rejection since an appellant cannot show nonobviousness by attacking references individually where the rejection is based upon a combination of references. *See In re Young*, 403 F.2d 754, 159 USPQ 725 (CCPA 1968). The assertion that providing a cross-strap on the Mazzoni carrier would increase the overall size so as to prevent its being placed in a wearer's pocket as intended by Mazzoni (col. 1, lines 65-67) is speculative inasmuch as there is no evidence in the record which supports the assertion. The argument that appellant's claimed ski carrier is sufficiently large that it is worn as a belt around the waist of the user when not in use (main brief, page 6) fails at the outset because it is predicated on limitations that are not found in the claims. The argument that there is no need for a cross strap in Mazzoni since it may be hand held is not well taken because it ignores the fact that Mazzoni states that the carrier may be hand held or placed over the shoulder (col. 1, line 50). Finally, we simply disagree with the appellant's argument that providing Rischard's cross strap in Mazzoni would not result in the claimed placement of the cross strap relative to the end straps.

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In view of the foregoing, we will sustain the rejection of claim 11 as being unpatentable over Mazzoni in view of Rischard. We will also sustain the rejection of claims 12, 15, 16 and 19 since appellant expressly states that these dependent claims stand or fall with the independent claim. See page 5 of the main brief.

Dependent claims 13 and 14 call for a first piece of fastening material located at an end of an auxiliary strap and a second piece of fastening material *located on an end strap*, with the auxiliary strap surrounding a pair of ski poles and attached to said end strap by means of mating together of the first and second pieces of fastening material. We appreciate that Saka discloses a ski carrier comprising a transverse auxiliary strap 20 that can be disposed about ski poles. We also appreciate that Saka discloses cooperating fastening means at the ends of the transverse auxiliary strap for forming the strap into a loop. However, we find no disclosure in Saka, or either of the other references relied upon by the examiner, of the particular placement of fastening material called for by the claims, i.e., a first piece of fastening material located on an end of the auxiliary strap and a second piece of fastening material *located on an end strap* for cooperating with the first piece to hold ski poles. In this regard, we do not agree with the examiner that

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Saka discloses "auxiliary strap 20 which is fastened to *another strap* via a self-locking fastening material in order to easily mount the poles to the strap 10" (answer, page 6; emphasis added). Accordingly, we think that, at best, Saka would have suggested providing the Mazzoni/Rischarde ski carrier with a transverse auxiliary strap for ski poles wherein *opposite ends* of the auxiliary strap are provided with cooperating pieces of fastening material for forming the strap into a loop to hold ski poles. This is not, however, what the claims require. Hence, we will not sustain the rejection of claims 13 and 14 as being unpatentable over Mazzoni in view of Rischarde and Saka.

We also will not sustain the examiner's rejection of claim 20 as being unpatentable over Mazzoni in view of Rischarde. The examiner considers that one end of the strap of Mazzoni is capable of being rolled along itself in order to shorten the overall length of the shoulder strap. Even if we accept this proposition, we find no response in Mazzoni as modified by Rischarde for the piece of self-locking material located on the shoulder strap between the first and second end straps for preventing the one end from unrolling, as now claimed.

*The § 102 Rejection*

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). In order to meet the recited functional limitations of a claim, the reference must include structure that is at least capable of performing the recited function. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977).

The anticipation rejection before us is an unusual one in that two references are included in the statement of the rejection (claim 11 is anticipated by "Rischarde and Dyess" (supplemental answer, page 2)). The principle reference cited against the claim is Rischarde. The justification for the additional use of Dyess is explained as follows:

[S]hould the Applicant contend the Rischarde device is not applicable against the claims because it is not intended to carry skis, it is the Examiner's position that in the absence of any claimed structure that would preclude using the Rischarde device to carry skis, it is considered capable of carrying skis. In support of this position, attention is directed to the Dyess reference which discloses another ski carrier wherein clip arrangements 30 are used to attach a shoulder strap 20 to a pair of skis. Accordingly, the clips 11 and 12 in the Rischarde device could easily and readily be attached to the D-rings 38 in the Dyess device should a user so desire to use the Rischarde device to carry skis [answer, page 8].

We think we get the point the examiner is trying to make in citing the additional Dyess reference. In the present instance, however, it is clear that the examiner, in the guise of utilizing Dyess as evidence to support his contention that the end structure of Rischard's shoulder strap is capable of being attached to the opposite ends of a pair of skis for transporting same, is in reality **adding** structure to that of Rischard in an effort to support his theory of anticipation. From our perspective, Dyess does not support the examiner's contention that hooks such as elements 11, 12 of Rischard are, in and of themselves, capable of being attached to the ends of a pair of skis for transporting same. Rather, what Dyess shows is that hooks 30 **in combination with additional structure** such as D-ring 38 and strap 40 may function in this manner. If anything, Dyess demonstrates that Rischard's end structure alone is **not** capable of the function attributed to it by the examiner.

We have reviewed the Rischard patent cited by the examiner against claim 11 but find nothing therein that supports the examiner's position that the end structure of Rischard's shoulder strap is capable of functioning to transport a pair of skis. Likewise, nothing in Dyess supports the examiner's position. Therefore, we will not sustain the standing anticipation rejection.

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## Summary

The rejection of claims 11, 12, 15, 16, 19 and 20 as being unpatentable over Mazzoni in view of Rischard is affirmed with respect to claims 11, 12, 15, 16 and 19 but is reversed with respect to claim 20.

The rejection of claims 13 and 14 as being unpatentable over Mazzoni in view of Rischard and further in view of Saka is reversed.

The rejection of claim 11 "as being anticipated by Rischar and Dyess" is reversed.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART**

Will. 2. Lyne

WILLIAM E. LYDDANE  
Administrative Patent Judge

Charles E. Frankfurt

CHARLES E. FRANKFORT  
Administrative Patent Judge

Laurence. Stach

LAWRENCE J. STAAB  
Administrative Patent Judge

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*APPENDIX*

11. A carrier by which to enable a user to transport pairs of skis and poles, each of said skis and poles having first and second ends, and said carrier comprising:

a first end strap adapted to be attached to the first ends of said pair of skis to be transported;

a second end strap adapted to be attached to the second ends of the skis to be transported;

a shoulder strap connected between said first and second end straps and adapted to be worn over a shoulder of the user after said first and second end straps have been attached to said skis; and

a cross strap to be attached to said shoulder strap to exert a pulling force thereon so as to prevent said shoulder strap from sliding off the shoulder of the user, said cross strap having a first end thereof attached to one of said first or second end straps and an opposite end releasably attached to said shoulder strap such that said cross strap extends from the one of said first or second end straps, across the back and under the shoulder of the user, to said shoulder strap to be releasably attached thereto adjacent the user's chest so that said cross strap exerts the pulling force on said shoulder strap in a direction across the chest of the wearer.